

ESTTA Tracking number: **ESTTA138972**

Filing date: **05/04/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
Correspondence Address	James A. Oliff OLIFF & BERRIDGE, PLC 277 South Washington Street, Suite 500 Alexandria, VA 22314 UNITED STATES email@oliff.com
Submission	Applicant's Request to Extend
Attachments	Motion to Extend Time.pdf (23 pages)(608386 bytes)
Filer's Name	William P. Berridge
Filer's e-mail	email@oliff.com
Signature	/William P. Berridge/
Date	05/04/2007

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the Application of

RIGHT-ON CO., LTD.

Serial No.: 79/011,373

Filed: April 21, 2005

Mark: HONEYSUCKLE ROSE

Examining Attorney: Melissa Vallillo

Law Office 113

Docket No.: 127939

MOTION TO EXTEND TIME

Applicant Right-On Co., Ltd., by and through counsel, hereby moves to extend time pursuant to Fed. R. Civ. P. 6(b), made applicable to Board proceedings by 37 C.F.R. §2.116(a). Specifically, Applicant requests a one month extension of time to prepare and file a reply to the Examining Attorney's Appeal Brief. The good cause for such relief is discussed below.

The USPTO failed to direct correspondence to Applicant's counsel, as previously requested, and thereby subjected Applicant to an unreasonably shortened time period for response to the Examining Attorney's Appeal Brief. Indeed, despite Applicant's express request that PTO correspondence be directed to Applicant's counsel in Alexandria, Virginia, and the fact that the correspondence address was so-changed in the USPTO records, the Examining Attorney's Appeal Brief, mailed April 18, 2007, was instead mailed to the former correspondent in Japan.

As early as December 6, 2006, Applicant provided the Trademark Office with new correspondence information. Specifically, Applicant indicated that correspondence should be directed to James A. Oliff of Oliff & Berridge, PLC in Alexandria, Virginia. See December 6, 2006

Response to Office Action which is attached as Exhibit A. The proper address was also indicated in the correspondence section of the Response to Office Action. *Id.* In fact, Applicant understood that this change was accepted in light of the Receipt of Notice of Appeal mailed December 8, 2006. Exhibit B. The Notice of Appeal again indicates the address of Applicant's counsel.

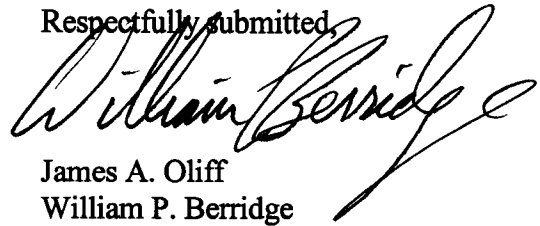
The USPTO accepted the request that correspondence be directed to James A. Oliff at Oliff & Berridge, PLC. For example, the Request for Reconsideration Denied mailed on December 29, 2006, was mailed to James A. Oliff. The correct correspondent address is expressly indicated thereon. See Exhibit C. Similarly, the December 29, 2006 notice from the Trademark Trial and Appeal Board that the appeal is resumed was mailed on January 8, 2007 to James A. Oliff at Oliff & Berridge in Alexandria, Virginia. Applicant's Request for Oral Hearing was made on March 2, 2007, and again indicated correspondent's address of James A. Oliff of Oliff & Berridge in Alexandria, Virginia. See Exhibit D. Similarly, Applicant's Appeal Brief was filed on March 2, 2007 and again indicated the correspondent's address to be that of James A. Oliff.

The Trademark Trial and Appeal Board sent by e-mail and U.S. Postal Service confirmation of receipt of Applicant's Brief and Request for an Oral Hearing on March 2, 2007, to the correct correspondence address. See Exhibit E.

Applicant's counsel first received a copy of the PTO appeal brief on May 2 from the foreign prior correspondent. Due to no malfeasance on the part of Applicant, Applicant would be unduly prejudiced by the time constraints imposed on Applicant and its counsel by the misdirected correspondence. In addition, Applicant's counsel needs to correspond with a foreign applicant, through foreign counsel, in order to prepare a reply. Thus, Applicant respectfully requests a one month extension of time in which to prepare Applicant's reply and afford Applicant the opportunity to correspond with Applicant's counsel in preparation of the reply.

In accordance with the foregoing, Applicant moves to extend the time for reply to
Examining Attorney's Appeal Brief by one month to JUNE 8, 2007.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "William P. Berridge".

James A. Oliff
William P. Berridge
Attorneys for Applicant

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone No.: (703) 836-6400

A

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79011373
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	

The Office Action refuses registration of Applicant's mark on the basis of an alleged likelihood of confusion with the mark in U.S. Registration No. 2653702 (HONEYSUCKLE & Design). Specifically, the Examining Attorney asserts that the marks convey "highly similar commercial impressions" on the basis that both marks contain the term HONEYSUCKLE. In this case, however, both marks are composite marks with both literal and design or stylized elements. The fundamental rule in this situation is that the marks must be considered *in their entirety*. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

The Examining Attorney then states, "The addition of the wording ROSE to the applicant's mark does not obviate the similarity between the marks because the applicant's mark incorporates the literal element of the registrant's mark entirely." In response, Applicant notes that it is well settled that a mark may entirely contain another mark without a finding of likelihood of confusion. See *In re Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) overturning rejection of registration for the mark TIC TAC for "candy" on the basis that it would be confused with the prior registered mark TIC TAC TOE for ice cream and sherbet; *The Conde Nast Pub, Inc v. Miss Quality, Inc.*, 507 F.2d 1404 (C.C.P.A. 1975) (no likelihood of confusion found between COUNTRY VOGUE for women's dresses and VOGUE for a women's fashion magazine.)

In the next sentence, the Examining Attorney states, "it is well settled that the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d)."

However, it is also well settled that exceptions to the above stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entirety convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984).

Last, the Examining Attorney has disregarded Applicant's argument relating to commercial impression. In its previous response, Applicant explained that its mark is not the name of a flower, but that the unitary term "HONEYSUCKLE ROSE" has an associated meaning that refers to a term of endearment. Indeed, the enclosed definition of the term HONEYSUCKLE ROSE contains no reference to flowers. Also, the fact that there is a separate definition of the term HONEYSUCKLE ROSE clearly indicates that this is a unitary term with a completely separate meaning than the meanings of its component parts. As reflected in its use in music and film, the term HONEYSUCKLE ROSE has taken

on cultural importance as evidenced by the numerous businesses that have appropriated this mark in their business names. (See enclosed website printouts).

In response to this argument, the Examining Attorney stated:

In this case, inquiry as to a likelihood of confusion must focus upon the goods for which the applicant seeks to register its mark and for which the registrant uses its mark (i.e., clothing and apparel). As such, inquiry as to the mark's significance in the field of music and film is inappropriate.

However, Applicant's reference to the use of the term HONEYSUCKLE ROSE in music and film is offered by Applicant to demonstrate the cultural significance of this term not in the music and film industries per se, but instead in the minds of the general consuming public, including consumers of the goods identified in the present application, and the effect of that cultural *meaning and connotation* on the commercial impression of the mark HONEYSUCKLE ROSE. When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). The cited mark is the name of a flower, and a flower is depicted in the design element of that mark. Accordingly, the average purchaser is likely to retain the image of the honeysuckle flower. By contrast, Applicant's mark evinces the unrelated cultural meaning of HONEYSUCKLE ROSE. Because of this cultural significance, consumers are likely to perceive and retain a completely different impression than they would when encountering the term "honeysuckle" alone.

Based on the arguments discussed above, there is no likelihood of confusion between the cited mark and Applicant's mark.

EVIDENCE SECTION

EVIDENCE
FILE NAME(S)

evi_151200228163-141502799_definition.jpg

evi_151200228163-141502799_Evidence_1.jpg

evi_151200228163-141502799_evidence_2.jpg

evi_151200228163-141502799_evidence_3.jpg

DESCRIPTION OF EVIDENCE FILE

Web definition and screen captures of three businesses.

CORRESPONDENCE SECTION

NAME

James A. Oliff

CONFIRM NAME

OLIFF & BERRIDGE, PLC

STREET

277 South Washington Street

CITY

Alexandria

STATE

Virginia

ZIP/POSTAL CODE

22314

COUNTRY

United States

PHONE

703-836-6400

FAX

703-836-2787

EMAIL email@oliff.com

AUTHORIZED TO COMMUNICATE VIA
E-MAIL Yes

SIGNATURE SECTION

RESPONSE SIGNATURE /William P. Berridge/

SIGNATORY'S NAME William P. Berridge

SIGNATORY'S POSITION U.S. Attorney for Applicant

DATE SIGNED 12/06/2006

AUTHORIZED SIGNATORY YES

[Back](#)

Response to Office Action Form

Original Mark:

[http://tess2.us
getImage=79](http://tess2.uspto.gov/getImage=79)

**HONEYSUCKLE
ROSE**

[Back](#)

Success!

We have received your form for serial number **79011373** . We will send an Email summary of the form to "**email@oliff.com**", which will be your official confirmation of receipt. For electronically-submitted forms, the USPTO will not mail any additional paper confirmation.

NOTE: Do **NOT** send a duplicate paper copy of this filing to the USPTO, as it will interfere with the proper processing of the electronic submission.

Thank you.

TEAS Support Team

STAMP: USPTO/ROA-151.200.228.163-20061206142356208001-79011373-360b9beecb23974cd4e4fee45664512f3da-N/A-N/A-20061206141502799861



Trademark Electronic Application System (TEAS) service
U.S. Patent and Trademark Office
Please refer questions or comments to: teas@USPTO.gov

B



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)**Electronic System for Trademark Trials and Appeals****Receipt**

Your submission has been received by the USPTO.
The content of your submission is listed below.
You may print a copy of this receipt for your records.

ESTTA Tracking number: **ESTTA113729**Filing date: **12/08/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No.	79011373
Applicant	RIGHT-ON CO., LTD.

Notice of Appeal

Notice is hereby given that RIGHT-ON CO., LTD. appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 79011373.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:

- IC 025

Respectfully submitted,
/William P. Berridge/
12/08/2006

James A. Oliff**U.S. Attorney for Applicant****OLIFF & BERRIDGE, PLC****Suite 500277 South Washington Street****Alexandria, VA 22314****UNITED STATES****email@oliff.com****703-836-6400**

[Return to ESTTA home page](#) **[Start another ESTTA filing](#)**

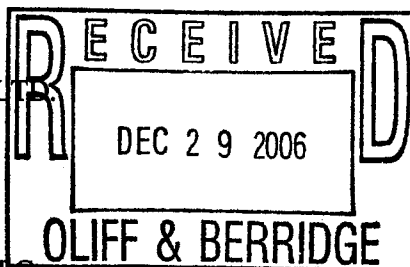
[HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

C

TM/WJH/KMP
Com/GRK**Communications Center****From:** ECom113 [Ecom1133@USPTO.GOV]**Sent:** Friday, December 29, 2006 4:58 PM**To:** Communications Center**Subject:** (Archive Copy) TRADEMARK APPLICATION NO. 79011373 - HONEYSUCKLE ROSE - N/A -
Message 1 of 3

127939

3

[Important Email Information]**UNITED STATES PATENT AND TRADEMARK OFFICE****SERIAL NO:** 79/011373**APPLICANT:** RIGHT-ON CO., LTD.**CORRESPONDENT ADDRESS:**James A. Oliff
OLIFF & BERRIDGE, PLC
Suite 500
277 South Washington Street
Alexandria VA 22314***79011373*****RETURN ADDRESS:**
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451If no fees are enclosed, the address should include
the words "Box Responses - No Fee."**MARK:** HONEYSUCKLE ROSE**CORRESPONDENT'S REFERENCE/DOCKET NO:** N/A**CORRESPONDENT EMAIL ADDRESS:**
email@oliff.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 79/011373

REQUEST FOR RECONSIDERATION DENIED

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments.

The applicant contends that the cited mark is the name of a flower while the applicant's mark is not. The applicant further contends that its mark evidences a cultural meaning relating to film or music. The applicant's arguments are unpersuasive in that, as the attached evidence shows, the term "honeysuckle" identifies as type of flower, as does the term "rose." Accordingly, the applicant's mark is comprised of two separate and distinct terms, each of which identifies a type of flower.

Moreover, as noted previously, if the goods of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as

12/29/2006

would apply with diverse goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980); TMEP §1207.01(b). In this case, the goods of the parties are identical in part in that they both feature jeans, t-shirts, sweaters, sweatshirts, belts, shoes, caps and hats. They are also highly similar in that the non-identical goods featured in the applicant's and the registrant's recitation of goods are often sold together in similar channels of trade. As the attached internet evidence shows, polo shirts, gloves and socks, as well as jackets, scarves and blouses, dresses and skirts, are often sold together in similar channels of trade.

Accordingly, no new issue has been raised and no new compelling evidence has been presented with regard to the points at issue in the final action. TMEP §715.03(a). Therefore, the request for reconsideration is **denied** and the final refusal is continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

/Melissa Vallillo/
Examining Attorney
Law Office 113
Phone: (571) 272-5891
Fax: (571) 273-9113

Note:

In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 3 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:

Email 1 includes the following 1 attachment

1. honey0

Email 2 includes the following 1 attachment

1. honey01

Email 3 includes the following 10 attachments

1. honey1
2. honeysuckle2
3. honey2
4. honey3
5. honey4
6. honey5
7. honey6
8. honey7
9. honey8
10. honey9

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

D

**United States Patent and Trademark Office**[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)***Electronic System for Trademark Trials and Appeals*****Receipt**

Your submission has been received by the USPTO.
The content of your submission is listed below.
You may print a copy of this receipt for your records.

ESTTA Tracking number: **ESTTA127835**Filing date: **03/02/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
Correspondence Address	James A. Oliff OLIFF & BERRIDGE, PLC 277 South Washington Street, Suite 500 Alexandria, VA 22314 UNITED STATES email@oliff.com
Submission	Request For Oral Hearing
Attachments	oral_hearing.pdf (1 page)(20936 bytes)
Filer's Name	William P. Berridge
Filer's e-mail	email@oliff.com
Signature	/William P. Berridge/
Date	03/02/2007

[Return to ESTTA home page](#) **[Start another ESTTA filing](#)**

[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)


United States Patent and Trademark Office
[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Electronic System for Trademark Trials and Appeals

Request For Oral Hearing

Navigation: [Home](#) - [Site Index](#) - [Search](#) - [Guides](#) - [Contacts](#) - [eBusiness](#) - [eBiz alerts](#) - [News](#) - [Help](#) - [Sign](#)

PTO-2189 (Exp. 9/30/2007)

OMB No. 0651-0040 (Exp. 9/30/2007)

Signature

The request must be signed by the filer. The request will not be "signed" in the sense of a traditional paper document. To sign the request, the signer must enter any combination of printable characters that have been adopted to serve the function of a signature, preceded and followed by the forward slash(/) symbol. Acceptable "signatures" could include: /john doe/, /jd/, and /123-4567/.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
Correspondence Address	James A. Oliff OLIFF & BERRIDGE, PLC 277 South Washington Street, Suite 500 Alexandria, VA 22314 UNITED STATES email@oliff.com
Submission	Request For Oral Hearing
Attachments	oral_hearing.pdf (1 page)(20936 bytes)

Filer Information

Fill in the information below. You will receive an e-mail confirmation of your filing within 24 hours. Your paper will be considered by the Board in due course.

Filer's Signature *	/William P. Berridge/
Filer's Name *	William P. Berridge
Filer's E-Mail Address *	email@oliff.com Note: Multiple e-mail addresses may be provided separated by commas
Date	03/02/2007

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

03/02/2007 04:52 PM EST

**United States Patent and Trademark Office**[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)**Electronic System for Trademark Trials and Appeals**

Request For Oral Hearing

Navigation: [Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#) | [Validate](#)

PTO-2189 (Exp. 9/30/2007)

OMB No. 0651-0040 (Exp. 9/30/2007)

Validate and Submit

Review the information below and click on the "Submit" button if the information is correct. If you need to edit any information, go back to proper screen using navigation facilities on this web page and make your correction(s).

DO NOT USE THE BACK BUTTON ON YOUR BROWSER.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
Correspondence Address	James A. Oliff OLIFF & BERRIDGE, PLC 277 South Washington Street, Suite 500 Alexandria, VA 22314 UNITED STATES email@oliff.com
Submission	Request For Oral Hearing
Attachments	oral_hearing.pdf (1 page)(20936 bytes)
Filer's Name	William P. Berridge
Filer's e-mail	email@oliff.com
Signature	/William P. Berridge/
Date	03/02/2007

 [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

03/02/2007 04:52 PM EST

E

File/TM 38
Comm/Comm+

Communications Center

From: ESTTA@uspto.gov
Sent: Friday, March 02, 2007 8:46 PM
To: Communications Center
Subject: TTAB Response

127939

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 2, 2007

In re RIGHT-ON CO., LTD.

Serial No. 79011373

Filed: 4/21/05

James A. Oliff
OLIFF & BERRIDGE, PLC
277 South Washington Street, Suite 500
Alexandria, VA 22314

Denise M. DelGizzi, Supervisory Paralegal Specialist

Applicant's brief and request for an oral hearing, filed March 2, 2007, are noted and the application file is forwarded herewith to the Trademark Examining Attorney for her brief in accordance with Trademark Rule 2.142(b).^[1]

RECEIVED
OLIFF & BERRIDGE, PLC
2007 MAR -5 A 9:32

^[1] An oral hearing will be scheduled in due course.